

III. Summary of the Office Action

In the Office Action dated August 9, 2000, the Examiner has made or maintained three rejections of claims 46-54, and has indicated that claims 30-45 are allowed. Applicants acknowledge the allowance of claims 30-45, and respectfully offer the following remarks to overcome or traverse the rejections of claims 46-54.

IV. The Rejection Under 35 U.S.C. § 112, Second Paragraph, Is Accommodated

In the Office Action at page 2, sections 2-3, the Examiner has rejected claims 46-54 under 35 U.S.C. § 112, second paragraph, as being vague and indefinite due to the recitation in claim 46 of “derivatives thereof.” By the foregoing amendments, claim 46 has been amended to delete this recitation, thereby fully accommodating this rejection. Therefore, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, are respectfully requested.

V. The Rejections Under 35 U.S.C. § 102(b) Over Mullis and Lee Are Traversed

In the Office Action at page 3, section 5, the Examiner has rejected claims 46-54 under 35 U.S.C. § 102(b) as being anticipated by Mullis (U.S. Patent No. 4,800,159). In addition, at page 3, section 6, the Examiner has rejected claims 46-51 under 35 U.S.C. § 102(b) as being anticipated by Lee (U.S. Patent No. 5,187,085). Applicants respectfully traverse these rejections, and reiterate and incorporate by reference herein the remarks concerning these same rejections that were included in Applicants’ Amendment and Reply Under 37 C.F.R. § 1.111 filed on April 6, 2000 (“the 04/06/00 reply”). Applicants also wish to provide the following additional remarks.

In making this rejection, the Examiner contends that Applicants' arguments made in the 04/06/00 reply in traversal of these rejections are "not convincing because the phrase derivatives thereof [is] unclear as discussed in 112 2nd rejection above and therefore the rejections are maintained." Office Action at page 3, section 6, lines 9-11. As noted above, claim 46 has now been amended to delete the phrase "derivatives thereof." Thus, this basis for the rejections under 35 U.S.C. § 102(b) has been overcome.

Applicants again respectfully assert that Mullis and Lee do not disclose compositions comprising one or more of the components recited in the Markush group in claim 46 as currently presented. Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). Since Mullis and Lee fail to expressly or inherently disclose compositions comprising one or more of the components recited in the Markush group of claim 46, these references cannot and do not anticipate claims 46-54 as currently presented. Reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) over Mullis and Lee therefore are respectfully requested.

VI. Other Matters

Applicants note that the Examiner has attached, to the present Office Action, initialed copies of the Forms PTO-1449 that were submitted with Applicants' Second and Third Supplemental Information Disclosure Statements filed in the above matter on April 12, 2000, and June 26, 2000, respectively. However, an Examiner-initialed copy of the Form PTO-1449 submitted with Applicants' First Supplemental Information Disclosure statement, filed on April 6, 2000, was not attached to the present Office Action, and was not listed on the

accompanying Form PTO-326. Therefore, Applicants respectfully request that the Examiner provide, with the next communication to Applicants, an initialed copy of this Form PTO-1449 indicating that the document cited thereon has been considered, and also indicate this disposition in the official file wrapper of the present application.

VII. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

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